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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,216	11/21/2001	Elmo Marcus Attila Diederiks	NL 000637	3553

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EXAMINER

CHAI, LONGBIT

ART UNIT PAPER NUMBER

2131

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,216

Applicant(s)

DIEDERIKS ET AL.

Examiner

Longbit Chai

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Appeal Brief filed on 1/3/2006. Claims 1 – 7 were originally received for consideration and claim 3 is cancelled. Therefore, presently pending claims are 1, 2 and 4 – 7.

Response to Arguments

2. In view of the Appeal Brief filed on 1/3/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because the claim language “while the audio and/or video data is not externally available in digital form” is indefinite because the specific location of the audio and/or video data in the claim limitation is not precisely specified – for instance, before the audio and/or video data can be internally stored in a semiconductor memory as recited in claim 1, first of all, the said data must be externally available in digital form so that the original audio and/or video data can be transferred and stored accordingly. Therefore, it is unclear in its meaning and its context about what exactly to constitute “the audio and/or video data is not externally available in digital form”.

Any other claims not addressed are rejected by virtue of their dependency should also be corrected.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2131

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim limitation of claim 1 "while the audio and/or video data is not externally available in digital form" is not enabled by the specification in a way that what input (or output) at which stage (or component) and how exactly to make it not externally available of the said audio and/or video data while, contradictorily, it can be transferred and stored into the internal semiconductor memory as recited in claim 1. Therefore, the invention of claim limitation is not clearly and concisely defined / specified in a manner which can be carried out by one skilled in the art.

Any other claims not addressed are rejected by virtue of their dependency should also be corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Truchsess (U.S. Patent 5734726).

As per claim 1, Truchsess teaches a storage medium for storing audio and/or video data, the storage medium including a semiconductor memory for storing the audio and/or video data in digital form (Truchsess: Column 3 Line 52 – 53), characterized in that the storage medium includes a conversion unit for converting the digital audio and/or video data into analog audio and/or video output signals suitable for reproduction by a reproducing apparatuses, and in that the output lines of the storage medium, on which the analog audio and/or video output signals are made available to the reproducing apparatus, are connected to the conversion unit (Truchsess: Column 3 Line 52 – 58), for making only the analog audio and/or video output signals externally available from the storage medium (Truchsess: Figure 4 – 6), while the audio and/or video data is not externally available in digital form (Truchsess: Figure 4 – 6).

As per claim 2, Truchsess teaches characterized in that the conversion unit includes a decoder for decoding compressed and/or encoded data (Truchsess: Column 1 Line 45 – 47).

As per claim 4, Truchsess teaches characterized in that the semiconductor memory and the conversion unit are integrated in a single microchip (Truchsess: Figure 5 & Column 5 Line 34 – 37).

As per claim 5, Truchsess teaches characterized in that storage medium takes the form of a chip card (Truchsess: Figure 5: “voice IC” is a chip card).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Truchsess (U.S. Patent 5734726), in view of Micic (U.S. Patent 4905289).

As per claim 6, Truchsess does not disclose expressly characterized in that the semiconductor memory (3) is a read-only memory.

Micic teaches characterized in that the semiconductor memory is a read-only memory (Micic: see for example, Abstract Line 1 – 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Micic within the system of Truchsess because Micic teaches a simplified apparatus for digital storage of audio signals (Micic: see for example, Column 1 Line 54 – 55).

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Truchsess (U.S. Patent 5734726), in view of Scibora (U.S. Patent 6122230).

As per claim 7, Truchsess does not disclose expressly characterized in that the conversion unit is configurable subject to authorization control and/or irreversibly.

Scibora teaches characterized in that the conversion unit is configurable subject to authorization control and/or irreversibly (Scibora: see for example, Column 6 Line 24 -- 27).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Scibora within the system of Truchsess because Scibora teaches an enhanced security mechanism to prevent unauthorized use of the decoding software program associated with the conversion unit (Scibora: see Column 5 Line 55 – 56).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LBC

Longbit Chai
Examiner
Art Unit 2131



Primary Examiner
AU2131
1/21/06